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MAY 14 1984
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May 14, 1984

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Commissioner of Patents and Trademarks
U.S. Patent and Trademark Office
Washington, D.C. 20231

Attn: Trademark Trial and Appeal Board

Dear Sir or Madam:

Nintendo of America, Inc., by its attorneys, Mudge Rose Guthrie Alexander & Ferdon, hereby submits for filing Applicant's Request For Suspension of Proceedings in the following opposition proceeding: Universal City Studios, Inc. v. Nintendo of America, Inc., Opp. No. 68,799 (App. filed August 9, 1982).

Please acknowledge receipt of this document by stamping the copy of this letter enclosed for this purpose.

Sincerely,

Shelly B. O'Neill

Shelly B. O'Neill

Enclosure

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark application Serial No. 378,948 for DONKEY KONG JUNIOR, applicant Nintendo of America, Inc., filed August 9, 1982, and published in the Official Gazette on December 20, 1983, at TM 323.

UNIVERSAL CITY STUDIOS, INC.,	:	
Opposer,	:	Opposition No. 68,799
-against-	:	
NINTENDO OF AMERICA, INC.,	:	
Applicant.	:	

REQUEST FOR SUSPENSION OF PROCEEDINGS
BY THE PATENT AND TRADEMARK OFFICE

Nintendo of America, Inc., ("Nintendo"), applicant herein, by its attorneys, Mudge Rose Guthrie Alexander & Ferdon, hereby requests that the proceedings regarding the published trademark application of Nintendo of America, Inc. for registration of the mark DONKEY KONG JUNIOR, Serial No. 378,948, for "Video Output Game Machines and Parts Therefor" and the opposition by Universal City Studios, Inc. ("Universal"), opposer herein, be suspended pursuant to Trademark Rule 2.117. This request is made because the applicant and opposer have been engaged in a civil action which will be dispositive of, or, at the very least, have some bearing upon the proceedings before this Board. As described below, the United States District Court for the Southern District of New York in Universal City Studios, Inc. v. Nintendo Co., Ltd. and Nintendo of America, Inc., 82 Civ. 4259 (S.D.N.Y.) has held, inter alia, that Universal has no

trademark rights in King Kong and that there is no likelihood of confusion as to the source of Donkey Kong. Universal's appeal of the district court's decision is presently pending before the United States Court of Appeals for the Second Circuit.

In its opposition to Nintendo's trademark application, Universal contends that "applicant's said mark DONKEY KONG JUNIOR so nearly resembles the KING KONG name and trademark KING KONG as to be likely, when applied to applicant's goods, to cause confusion, to cause mistake and to deceive with consequent injury to Opposer, to the trade and to the public." Universal Opposition ¶14. Universal made these same allegations in its complaint, filed on June 29, 1982, in Universal City Studios, Inc. v. Nintendo Co., Ltd. and Nintendo of America, Inc., 82 Civ. 4259 (S.D.N.Y.), in which it contended that Nintendo's trademark Donkey Kong and any similar mark infringed on Universal's claimed exclusive property and trademark rights in the name, character and story of King Kong, thereby constituting a violation of Section 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125 (a), common law trademark infringement, unfair competition, trade name infringement and a violation of Section 368-d of the New York General Business Law. See Appendix A (Universal Complaint).

In the federal court action, Nintendo denied Universal's claims, asserted counterclaims (see Appendix B (Nintendo Answer)), and moved, after completion of discovery, for summary judgment dismissing Universal's complaint pursuant to Rule 56 of the Federal Rules of Civil Procedure. See Appendix C (Memorandum of Law in Support of The Defendants' Motion for Summary Judgment). Nintendo

argued that Universal's complaint should be dismissed as a matter of law because (1) Universal is estopped from asserting a trademark right in the King Kong property after having fully and successfully litigated the opposite position in a prior litigation, (2) Universal has no property or trademark rights in the name, character and story of King Kong that it can assert against Nintendo, (3) through its agreements with Nintendo's licensees, Universal has abandoned any alleged trademark claim in King Kong and admitted that Donkey Kong is not an infringement of King Kong, (4) the name, character and story of King Kong have lost any trademark significance they once may have had, (5) even if Universal owned a valid trademark interest in King Kong, there is no likelihood of any confusion as to the origin of Donkey Kong, and (6) Universal cannot establish the necessary elements for a dilution claim under Section 368-d of the New York General Business Law.

The United States District Court for the Southern District of New York heard oral argument on Nintendo's summary judgment motion on August 8, 1983, and on December 22, 1983, granted Nintendo's motion for summary judgment and dismissed Universal's complaint, finding, inter alia, that Universal has no trademark rights in King Kong and that there is no likelihood for confusion as to the source of Donkey Kong. See Appendix D (Universal City Studios, Inc. v. Nintendo Co., Ltd. and Nintendo of America, Inc., 82 Civ. 4259 (S.D.N.Y. Dec. 22, 1983)). Universal appealed the district court's decision to the United States Court of Appeals for the Second Circuit in Universal City Studios, Inc. v. Nintendo Co., Ltd. and Nintendo of

America, Inc., No. 84-7095. The Second Circuit is scheduled to hear oral argument on the appeal on May 23, 1984.

Because the issues presented in the federal court action are essentially the same as and will be dispositive of or have some bearing upon the issues presented by Universal's opposition to Nintendo's application for registraton of the trademark DONKEY KONG JUNIOR, Serial No. 378,948, this Board should suspend the proceedings herein until termination of the pending litigation. This Board previously considered and granted on November 10, 1983, a similar request for suspension of proceedings regarding the published trademark application of Nintendo for registration of the mark DONKEY KONG & DESIGN, Serial No. 330,932, for electronic coin operated video games using a video display, and the opposition filed by Universal, Opposition No. 67,904. See Appendix E (Order of Trademark Trial and Appeal Board).

Nintendo of America, Inc., therefore, respectfully requests that the proceedings before the Trademark Trial and Appeal Board be suspended until termination of the federal court action. If this Board declines to grant this request for suspension, then Nintendo

respectfully requests that it be allowed thirty (30) days after such determination by the Board in which to file an answer to Universal's opposition.

Dated: May 11, 1984

Respectfully submitted,

MUDGE ROSE GUTHRIE ALEXANDER & FERDON

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